

Application No.: 10/757,837
Filing Date: January 15, 2004
Page: 5

REMARKS

The Office Action indicated that Claims 1-5, 8-12, 14 and 16-21 are pending in this Application. It is believed that actually Claims 1-5, 7-12, 14 and 16-21 are pending in the application.

Claim 1 has been cancelled. Applicant, however, reserves the right to file a divisional Application directed to the cancelled subject matter.

Claims 2, 3, 5, 7-10, 12, 14 and 16-19 have been made dependant on a combination of previously presented Claims 20 and 21.

Claim 4 has been amended to define the range of poly(m-xylenedipamide) in the base layer (B) as comprising "up to 30% by weight".

Applicants respectfully submit that this response does not raise new issues, but merely places the above-referenced application either in condition for allowance, or alternatively, in better form for appeal. Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

Section 112 Rejection

Claims 1-5, 7-12, 14, 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is the Examiner's position that the newly added limitation, "said overlayer (A) forming an outermost layer of said film" in claim 1 has no support in the application as originally presented.

Application No.: 10/757,837
Filing Date: January 15, 2004
Page: 6

Although Applicant does not concur with the Examiner's point of view, claim 1 has been cancelled so that this ground of rejection should be withdrawn. Applicant, nevertheless, reserves the right to file a divisional Application directed to the cancelled subject matter.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. It is the Examiner's position that the claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Claim 4 recites the amount of poly(m-xylenedipamide) to be 0-30% by weight in the base layer. Since claim 4 depends on claim 3, which recites the presence of poly(m-xylenedipamide) in the base layer, the compound cannot be 0% by weight in claim 4.

Claim 4 has been amended to address this issue. The amount has been amended to read "up to 30% by weight". This range is not in contradiction to claim 3 which already recites the presence of poly(m-xylenedipamide) nor does it violate the written description requirement of 35 U.S.C. 112, first paragraph, as the range of up to 30% by weight is clearly disclosed in the specification, e.g. at page 3, line 22 or page 6, lines 23-26.

Accordingly, Applicants respectfully request withdrawal of this rejection.

Objection under 37 CFR 1.75(c)

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. It is the Examiner's position that Claim 11 repeats the same limitation of the polyester as recited in claim 1.

Applicant respectfully disagrees. Claim 1 states that the base layer (B) comprises thermoplastic polyester and that the overlayer (A) comprises a mixture of thermoplastic polyester selected from one or more compounds. Claim 10, which is the claim from which claim 11

Application No.: 10/757,837
Filing Date: January 15, 2004
Page: 7

depends, requires that the film has an ABC layer structure, wherein layers A and C are overlayers which may be identical or different. Claim 11 then requires that the overlayers of claim 10 comprise polyester which is used for the base layer (B). Claim 1 does not say that the polyester mixture for overlayer (A) which is selected from one or more compounds has to comprise polyester which is used for the base layer (B). To this extend claim 11 limits the subject matter of previous claim 10, i.e. claim 1.

Applicants respectfully request withdrawal of this objection.

The Claimed Invention is Patentable
in Light of the Art of Record

Applicants acknowledge that the rejection of claims 1-5, 7-12, 14, and 16-21, under 35 U.S.C. 102(e) as being anticipated by Shelby et al. (US Pat. 6,562,276), has been withdrawn.

Applicants further note that claims 1-5, 7-12, 14, 16-17, 19 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (5,314,987).

Applicants further note that claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim as applied to claim 1 above.

In view of the Examiner's statement under item 11 and 12 of the Office Action and Applicants amendment of the claims especially the cancellation of claim 1 and the introduction of claim 20/21 as main independent claim, the rejections under 35 U.S.C. 102(b) and 103(a) are deemed to be overcome.

Under item 11 and 12 of the Office Action the Examiner indicated that claim 21 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It is acknowledged that no prior art has been found, whether alone or in combination, to teach, disclose, or fairly suggest a polyester film comprising a layer C disposed on layer B

Application No.: 10/757,837
Filing Date: January 15, 2004
Page: 8

or the surface opposite layer A, wherein layer C alone comprises at least one anti-blocking agent; in combination with all of the other limitations in claims 20 and 21.

Applicants have combined claims 20 and 21 into a separate independent claim (20) and made all other claims either directly or indirectly dependent from this claim.

Accordingly, Applicants respectfully submit that Claims 2 through 5, 7 through 12, 14, and 16 through 20 are patentable.

CONCLUSION

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 2 through 5, 7 through 12, 14, and 16 through 20 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time and/or fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,



Klaus Schweitzer, Lim Rec. No. L0086
ProPat, L.L.C.
425-C South Sharon Amity Road
Charlotte, NC 28211-2841
Telephone: (704) 365-4881;
Fax: (704) 365-4851

Application No.: 10/757,837
Filing Date: January 15, 2004
Page: 9

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at facsimile number (571) 273-8300 on December 20, 2005.

Claire Wygand Claire Wygand